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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/070,801	06/10/2002	Jean-Paul Dumortier	324-142	2880

22429 7590 01/18/2007
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EXAMINER

HAMANN, JORDAN J

ART UNIT	PAPER NUMBER
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2616

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/18/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

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Office Action Summary	Application No.		Applicant(s)	
	10/070,801		DUMORTIER ET AL.	
	Examiner		Art Unit	
	Jordan Hamann		2616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-11 is/are rejected.
- 7) ☒ Claim(s) 7 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 June 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/12/02</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The abstract of the disclosure is objected to because it should be a single paragraph. Correction is required. See MPEP § 608.01(b).

Claim Objections

2. Claims 2 and 3 are objected to because of the following informalities:
3. Claim 2 recites the limitation "said step of setting up said link between said first terminal and second terminal includes opening a virtual circuit on a signaling channel" in the 2nd and 3rd lines. The step of setting up a link in claim 1 is between first terminal and third terminal. In Figure 2 Element 26 and on pages 8 and 11 of the specification a link is set up between first and third terminals using signaling channel D, whereas the link between the first and second terminals is on a data channel B (Figure 2 Element 16).

It is interpreted for further examination of claim 2 in this Office Action that limitation should read "said step of setting up said link between said first terminal and third terminal includes opening a virtual circuit on a signaling channel".

4. Claim 3 recites the limitation "said link between said first terminal and third terminal uses a data channel" in 2nd and 3rd lines. In Figure 2 Element 26 and on pages 8 and 11 of the specification the link between first and third terminals uses signaling channel D, whereas the link between the first and second terminals is on a data channel B (Figure 2 Element 16).

Art Unit: 2616

It is interpreted for further examination of claim 3 in this Office Action that the limitation should read "said link between said first terminal and second terminal uses a data channel".

Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claim 8 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for validating an operation between first and second terminals connected by data channel B, via signaling channel D on an ISDN network connecting first and third terminals, does not reasonably provide enablement for link between first and third terminals using short message service on a radio telephone network. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims. The specification only discloses using a short message service to set up a link between the first and third terminals of the network. It is not clear how the first and second terminals are connected in the digital radio telephone network, how the operation between the first and second terminals is validated by the

Art Unit: 2616

third terminal, or how an acknowledgement message confirming validation of the operation is sent from the third terminal to the second terminal.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "said other logical channel" in the 6th line. There is insufficient antecedent basis for this limitation in the claim. The 3rd line of claim 1 recites "another logical channel".

It is interpreted for further examination of claim 1 in this Office Action that "another logical channel" and "said other logical channel" are one and the same.

9. Claims 9-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9 lacks a transitional phrase, such as "comprising", to separate the preamble from the body of the claim.

The claims are generally narrative and indefinite, failing to conform with current U.S. practice.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1, 9 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Fraser (Us 5,329,589).

With respect to claim 1, Fraser discloses a method of validating an operation during a call set up between first terminal and second terminal via a digital telecommunication network, said call using a logical channel of a digital multiplex link including another logical channel to carry data (Figure 4), said method comprising the following steps;

during said call, setting up a link between said first terminal and a third terminal via said other logical channel of the digital multiplex link (column 8 lines 40-43),

transferring between said first terminal and said third terminal via said other logical channel, confidential data not accessible to said second terminal for validating said operation effected during said call between said first terminal and second terminal (column 8 lines 43-48), and

sending an acknowledgement message confirming the validation of said operation from said third terminal to the second terminal (column 8 lines 59-65).

With respect to claim 9, Fraser discloses a communications system for validating an operation during a call set up between a first terminal and a second terminal via a digital telecommunication network (Figure 4 Elements 403 & 405), said call using a logical channel of a digital multiplex link including another logical channel to carry data comprising;

said another logical channel between a third terminal and said first terminal to exchange confidential data not accessible to said second terminal (column 8 lines 40-43); and

a link between said third terminal and said second terminal to send an acknowledgement message confirming validation of said operation (column 8 lines 59-65).

With respect to claim 10, Fraser discloses, wherein said first terminal is that of a user, such as a customer (Figure 4 Element 403), and said second terminal is that of another user, such as a vendor (Figure 4 Element 405), so that said operation validated during said call between said first terminal and second terminal is a telepayment effected by said user of said first terminal to the benefit of said user of said second terminal and validated by said confidential data exchanged between said first terminal and third terminal (column 8 lines 40-65).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 2-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fraser (US 5,329,589) in view of Gore et al. (US 5,313,463).

With respect to claims 2 & 3, Fraser does not disclose the telecommunication network is an ISDN network.

Gore discloses an ISDN network used for communication between a business and a customer wherein the business and customer terminals communicate via a B channel and the D channel is used to validate customer information such as a credit card number by a third terminal (column 1 lines 46-68).

Fraser and Gore are analogous art because they are from the same field of endeavor of validating customer information by a third terminal in a telecommunication network.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use an ISDN network in the invention of Fraser, using the B channel for communication between the customer and vendor and the D channel for validating customer information with a third terminal.

The motivation for doing so would have been to use a well-known telecommunication network which has a signaling channel that can be used to validate customer information instead of using another data channel or a private line facility (column 3 line 64 – column 4 line 42).

With respect to claim 4, Fraser discloses sending credit card information to a third terminal before setting up a link between second terminal (vendor/business) and the third terminal (column 8 lines 40-65) in a telecommunications network.

Gore discloses setting up a link between the second terminal and third terminal to request validation of customer information (credit card number), which the first terminal sends to the second terminal (column 3 line 64 – column 4 line 42) in an ISDN network.

Fraser and Gore are analogous art because they are from the same field of endeavor of validating customer information by a third terminal in a telecommunication network.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art for the vendor (second terminal) to request validation of customer information when the vendor wants validation that the customer can pay, while keeping the customer's credit card number hidden from the vendor by setting up a link between the customer (first terminal) and the third terminal.

The motivation for doing so would have been for the customer to keep his credit card number hidden from the vendor, while the vendor is assured the customer can pay

Art Unit: 2616

(Fraser column 8 lines 25-29), yet the customer does not have to send his information until the vendor requests it, which can be at any point during the transaction.

With respect to claim 5, Gore discloses wherein said step of setting up said link between said second terminal and third terminal includes opening a virtual circuit on a signaling channel (column 1 lines 46-68).

With respect to claim 6, Gore discloses wherein said link between said second terminal and third terminal and said call between said first terminal and second terminal are multiplexed on the same physical medium serving said second terminal from said network (ISDN D and B channels described in Figure 2 and column 3 line 64 – column 4 line 42).

14. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fraser et al. (US 5,329,589) in view of Linehan (US 6,327,578 B1).

Fraser discloses the third terminal is a credit manager connected to a credit card database, not a bank.

Linehan discloses validating an operation between a Consumer (Figure 4 Element 202) and a Merchant (Figure 4 Element 204), by a third terminal, the Consumer's Issuing Bank and Issuer Gateway (Figure 4 Elements 212 & 214) which issues an authorization token, including a reference to the Consumer's credit or debit card number, to the Merchant (column 6 lines 8-43).

Fraser and Linehan are analogous art because they are from the same field of endeavor of validating customer information by a third terminal in a communication network.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use the Issuer Gateway and Issuer Bank of Linehan in place of or in conjunction with the Credit Manager and Credit Card Database of Fraser.

The motivation for doing so would have been to for the Consumer/Customer to be able to use either a debit card or credit card.

Allowable Subject Matter

15. Claim 7 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

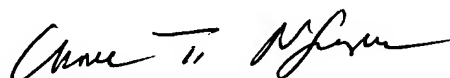
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jordan Hamann whose telephone number is (571) 272-8564. The examiner can normally be reached on Monday-Thursday 8:30-5:30 and alternate Fridays.

Art Unit: 2616

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chau Nguyen can be reached on (571) 272-3126. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JJH



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